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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,237	07/02/2001	Mika Munenaka	09792909-5086	8226
26263	7590	01/24/2006	EXAMINER	
SONNENSCHN NATH & ROSENTHAL LLP			AILES, BENJAMIN A	
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WACKER DRIVE STATION, SEARS TOWER			ART UNIT	
CHICAGO, IL 60606-1080			PAPER NUMBER	
			2142	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/897,237		MUNENAKA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Benjamin A. Ailes		2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/28/05</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. In view of the Appeal Brief filed on 19 September 2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al. (US 5,933,811), hereinafter referred to as Angles, in view of Prust (US 6,735,623).

5. Regarding claim 1, Angles discloses a content managing system having a content managing portion comprising:

a content library for storing files of a plurality of contents provided by a content provider (Angles, figure 4, item 70);

library managing means for managing said content library (Angles, figure 4, item 18);

Angles discloses in column 14, lines 23-26 the advertisement provider computer having registration capabilities. The registration steps include obtaining information pertaining to users and storing this information about the user in a database. Angles clearly discloses information related to a user but does not explicitly disclose the ability to store files for the user. However, in related art, Prust discloses a method for providing a remote storage area specifically for users in a computer networking environment where it would be considered desirable to store files remotely. The remote storage device disclosed by Prust is divided so that each user is assigned a specific

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storage area. The user is then able to access the remote storage from different locations over a network communication line from a user terminal. The user is also able to copy and store data files in their storage area (Prust, column 1, lines 30-37). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to provide a "customer file storing means" (remote storage area) as disclosed by Prust, in combination with the registration and user database as disclosed by Angles. One of ordinary skill in the art would have been motivated to make such a combination because of the benefit of being able to access data files from different locations (remote access).

6. Regarding claim 2, Angles discloses the content being advertisements (col. 2, lines 49-51).

7. Regarding claim 3, Angles discloses the content managing system wherein the content provider can freely change, replace, and delete the file of a content provided to said content library (col. 13, lines 21-23 and col. 15, lines 20-42, Angles discloses the advertisement provider having full control over maintaining the content stored (generating and deleting advertisements) in the content database.).

8. Regarding claim 4, as mentioned in the rejection of claim 1, Angles does not explicitly recite the use of a storage area specifically designated for each user, however Prust teaches this feature at length. Angles does in fact teach a method for statistics gathering. Angles utilizes an accounting database which tracks how often content is used (see Angles, col. 15, line 65 – col. 16, line 7). The reasoning and motivation to combine Angles and Prust as utilized in claim 1 applies equally as well to claim 4.

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9. Regarding claim 5, as mentioned in the rejection of claim 1, Angles does not explicitly recite the use of a storage area specifically designated for each user, however Prust teaches this feature at length. Angles does in fact teach a method for statistics gathering. Angles utilizes an accounting database which tracks how often content is used and tracks demographic information including sex (see Angles, col. 14, lines 19-23 and col. 15, line 65 – col. 16, line 7). The reasoning and motivation to combine Angles and Prust as utilized in claim 1 applies equally as well to claim 5.

10. Regarding claim 6, as mentioned in the rejection of claim 1, Angles does not explicitly recite the use of a storage area specifically designated for each user, however Prust teaches this feature at length. Angles does in fact teach a method for statistics gathering. Angles utilizes an accounting database which tracks how often content is used and tracks demographic information including age (see Angles, col. 14, lines 19-23 and col. 15, line 65 – col. 16, line 7). The reasoning and motivation to combine Angles and Prust as utilized in claim 1 applies equally as well to claim 6.

11. Regarding claim 7, as mentioned in the rejection of claim 1, Angles does not explicitly recite the use of a storage area specifically designated for each user, however Prust teaches this feature at length. Angles does in fact teach a method for statistics gathering. Angles utilizes an accounting database which tracks how often content is viewed (clicked) (see Angles, col. 4, lines 17-20, col. 14, lines 19-23 and col. 15, line 65 – col. 16, line 7). The reasoning and motivation to combine Angles and Prust as utilized in claim 1 applies equally as well to claim 7.

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12. Regarding claim 8, as mentioned in the rejection of claim 1, Angles does not explicitly recite the use of a storage area specifically designated for each user, however Prust teaches this feature at length. Angles does in fact teach a method for statistics gathering. Angles utilizes an accounting database which tracks how often content is viewed. How often content is viewed requires the time and date in order for the statistic to be calculated efficiently (see Angles, col. 14, lines 19-23 and col. 15, line 65 – col. 16, line 7). The reasoning and motivation to combine Angles and Prust as utilized in claim 1 applies equally as well to claim 8.

13. Regarding claim 9, as mentioned in the rejection of claim 1, Angles does not explicitly recite the use of a storage area specifically designated for each user, however Prust teaches this feature at length. Angles does in fact teach a method for statistics gathering. Angles utilizes an accounting database which tracks how often content is used (see Angles, col. 14, lines 19-23 and col. 15, line 65 – col. 16, line 7). The reasoning and motivation to combine Angles and Prust as utilized in claim 1 applies equally as well to claim 9.

14. Claims 10-18 and 19-27 contain similar subject matter and are rejected under the same rationale as claims 1-9.

### ***Response to Arguments***

15. Applicant's arguments filed 28 October 2005 have been fully considered but they are not persuasive.

16. (A) Applicant argues that Angles fails to teach "a library managing means for managing a content library." The Examiner respectfully disagrees. In figure 4, Angles

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uses an advertisement provider computer (item 18) (library manager) in order to manage an advertisement database (item 70) (content library). The advertisement provider computer controls the advertisement database by performing functions to the advertisement database (adding, deleting, retrieving, etc.). Therefore, it is concluded that the advertisement computer and advertisement database meet the claimed limitation "library managing means for managing a content library."

17. Applicant's arguments with respect to the independent claims (specifically in reference to the use of a storage area assigned to a specific user) have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cagle et al. (US 6,311,232 B1) disclose a method and apparatus for configuring storage devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A. Ailes whose telephone number is (571)272-3899. The examiner can normally be reached on M-F 6:30-4, IFP Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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1/21/06